

PATENT IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: KURODA, M.

PATENT NO.: 7,728,191

FOR: **A NUCLEIC ACID FOR REDUCING
PROTEIN CONTENT IN RICE SEED**

EXAMINER: WORLEY, CATHY K.

ART UNIT: 1638

CONFIRMATION No.: 8318

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. 1.705(d) AFTER PATENT ISSUANCE

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement of facts is being submitted in support of a Request for Recalculation of Patent Term Adjustment (PTA) appearing on the face of the patent, and is being submitted within two-months of issuance. Consideration of the remarks presented herein is respectfully requested.

With the Notice of Allowance mailed 17 February 2010, the estimated patent term was 233 days. On 1 June 2010, the patent issued with 934 days of PTA granted. Applicants believe the former estimated PTA date was not calculated in light of *Wyeth v. Dudas*, No. 2009-1120, *slip op.* (Court of Appeals for the Federal Circuit), whereas the latter was.

The application from which this patent issued was filed as a national phase filing under 35 U.S.C. § 371. 37 C.F.R. § 1.702(b) provides that, for a national phase filing, the actual filing date is the date that the national stage commenced under 35 U.S.C. § 371(b) or (f) (*i.e.*, 30-months from the earliest priority date, or when applicant explicitly requests early processing, respectively), rather than under 35 U.S.C. § 371(c) (*i.e.*, 12 April 2006, the date that the executed inventor declaration was filed), as Applicants believe the Patent Office to have used in their calculation.

Applicants submit that, due to an incorrect PTA calculation under 37 C.F.R.

1. 702(a) and the recent *Wyeth* decision the correct Patent Term. Adjustment should be at least an additional 295 days. Applicants request that the patent be granted an additional patent term of 293 days, for Patent Office delay to be added to that already calculated on PAIR and appearing on the face of the patent (934 days), resulting in a total PTA of at least 1229 days.

1. Statement of facts

Applicants' calculations for the correct PTA follow. PTA calculation for the 10/539,992 application begins with its filing under 35 U.S.C. § 371(b) on 20 June 2005. Notably, the difference in the number of days from 20 June 2005 (the actual filing date) to 12 April 2006 (the date the Patent Office used as the filing date for PTA calculation) is 295 days.

There are two instances of Patent Office delay under 37 C.F.R. §§1.702(a) and 1.702(b) that would lead to an addition of PTA days and three instances of Applicant delay under 37 C.F.R. §1.704 that would lead to a reduction in the PTA days.

1. Under 35 U.S.C. §154(b)(1)(A)(i) and 37 C.F.R. §§1.702(a)(1), the Office must mail a notification under 35 U.S.C. §132 or a notice of allowance under 35 U.S.C. §151 not later than 14 months after the filing date of the application. Because the filing date of the application was 20 June 2005, an Office Action was due 20 August 2006. However, the first Office Action, Requirement for Restriction, was not sent until 19 June 2008. The Office's delay in mailing this first action results in a credit of 668 days PTA.

2. On February 26, 2007, as response to the Requirement for Restriction was timely filed, but was considered non-compliant. The period of Applicants' delay is calculated from the day after the date of the reply having an omission, 19 November 2008, until the date that the omission was corrected in the response filed on 19 January 2009. Thus, Applicants' delay resulted in a debit of 122 days.

3. On 31 August 2009, Applicants filed a response to a Non-final Office Action, and then on 17 September 2009, Applicants filed an Information Disclosure Statement (IDS) not expressly requested by the examiner. Because the IDS did not accompany but was filed after Applicants' response, the delay period is calculated from the day after the date of Applications initial response, 31 August 2009 and ending on the day the IDS was filed. Thus, Applicants' delay resulted in a debit of 17 days.

4. A Notice of Allowance was received on 17 February 2010. On 22 March 2010, Applicants filed an amendment under 37 C.F.R. §1.312. The Office's response to Applicants' amendment under 37 C.F.R. §1.312 was dated 31 March 2010. A reduction in PTA begins on the date of Applicants' amendment under 37 C.F.R. §1.312, and ends on the mailing date of the Office's response. Thus, a debit of 10 days PTA results.

5. Under 35 U.S.C. §154(b)(1)(B) and 37 C.F.R. §§1.702(b) and 1.703(b), the Office must issue a patent within three years after the date on which the application was filed (i.e., the date national stage commenced under 35 U.S.C. § 371(b) or (f)). Because the filing date of the application was 20 June 2005, the expiry of the 3-year period to issue was 20 June 2008. However, the patent did not issue until 12 May 2010. The Office's delay results in a credit of 710 days PTA.

6. Thus, the total number of days of PTA should be the sum of [(668 days + 710 days = 1378 days of credit due to Office delays) minus (122 days + 17 days + 10 days = 149 days of debit due to Applicant delays) = 1229 days]. This is an adjustment of an additional 295 days to the 934 days of PTA shown on the face of the patent.

2. Payment of fee under §1.18(e)

Applicants hereby authorizes the Patent Office to charge the fee set forth in § 1.18(e) and any other fees that may be due to Deposit Account 50-4616.

Applicants respectfully request reconsideration and a recalculation of the Patent Term Adjustment. Applicants further request that, upon grant of this request, the file be forwarded to the Certificates of Correction branch for issuance of a Certificate of Correction, to correct the PTA stated on the face of the patent to at least 1229 days.

Respectfully submitted,
KING & SPALDING LLP

Date: 19 June 2010

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